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| PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824 | | | KYLE, CHARLES R | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,654

Applicant(s)

BROOKNER ET AL.

Examiner

Charles Kyle

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/2/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. They recite "communications" as what appears to be a system element. How this is possible is unclear.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It recites the phrase "personal computer bus protocols". Such protocols change over time and the language is thus indefinite.

Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It recites the phrase "externally readable identifier". It is unclear whether the identifier is merely readable or is actually read as part of the invention; no positive recitation of reading is present in the Claims.

Claim 4 recites the limitation "said circuitry" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the printing function" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. They recite that the invention is an entity, which is not a statutory class of invention. See MPEP 706.03(a). The fact that Claim 11 later recites that the entity is in the form of an apparatus further confuses the nature of the entity.

Claims 1-3, 14-17, 19-20 and 27-33 are additionally rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In *re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under § 101, but rather under §§ 102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a § 101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001), non-precedential but cited for its reasoning.

In the present application, Claims 1-3, 14-17, 19-20 and 27-33 have no connection to the technological arts. The recited functions could be performed by a person using pencil, paper and a simple filing system. Therefore, the claims are directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as

Art Unit: 3624

incorporating a computer or electronic devices into the various steps; for example in Claim 1: “a computer processor for processing instructions to assign a storage device to new application”.

The other claims could be similarly amended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by US

6,381,590 *Debois*.

With respect to Claim 1, *Debois* discloses the invention as claimed, including in an entity for securely storing a value indicative of funds available for use (Abstract; Fig. 3, ele. 25; Background of the Invention), comprising;

a first storage for storing said value (col. 3, lines 54-65);

an externally readable identifier within said entity for providing a unique identification of said entity (Col. 4, lines 52-56);

Art Unit: 3624

a second storage in said entity for storing information assigning said entity to operate in an application (Col. 5, lines 6-12); and

communications for changing said information so as to assign said entity to a new application (Col. 5, line 6 to Col. 6, line 65, particularly Col. 6, line 12-65).

Regarding Claims 2 and 3, *Debois* discloses a serial number, which is digital data/character string.

With respect to Claim 4, it inherent that the digital data cited would be stored in registers (circuitry) in the CPU as used by the CPU.

With respect to Claim 5, *Debois* further discloses:

an electrical connector for electrically connecting to said entity (Fig. 3, ele. 4), and an interface for supporting communication between said entity (Fig. 3, 313. 37) and an external system (Fig. 3, ele. 5), so that said entity can be identified by said external system by reading said identifier (Col. 4, lines 52-56).

With respect to Claim 8, *Debois* discloses a postal funds security device at Background and Summary of the Invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-18, 19-21, 24 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,381,590 *Debois*.

With respect to Claim 14, *Debois* discloses the invention substantially as claimed. See the discussion of Claim 1 above. *Debois* further discloses configuring the entity to operate in different applications at through reprogramming at Col. 6, lines 12-65, at least. *Debois* does not specifically disclose relation of the entity identifier to the particular application. A broad, reasonable reading of this limitation is that to assign a task to a particular resource, one must first (and trivially) identify which resource is to be used. Official Notice is taken that such task assignment was old and well known at the time of the invention. For example, it was old and well known to specifically identify computer resources for task assignment. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Debois* to include such identification for reconfiguring for task assignment because this would avoid ambiguities in the task management process.

Claim 15 is a subset of Claim 14 and is rejected in a like manner.

With respect to Claims 16-18, see the discussion of Claims 15 and 2-4 respectively.

Regarding Claims 19-21, see the discussion of Claims 15 and 5. Further, reading a resource identifier is inherent to assigning it to an application.

Regarding Claim 24, see the discussion of Claims 15 and 8.

With respect to Claim 30, see the discussion of Claim 14.

With respect to Claim 31, allowing function in a new environment would be obvious to provide portability for the entity.

Claims 6, 11-13, 22 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,381,590 *Debois* in view of US 5,689,098 *Gillerion*.

Regarding Claim 6, see the discussion of Claim 1. *Debois* discloses the invention substantially as claimed. *Debois* does not specifically disclose interface details. *Gillerion* discloses an RS-232 interface functioning with a postage meter to communicate with a computer “entity” at Col. 3, lines 32-44. It would have been obvious to one of ordinary skill in the art at the time of the invention to include such an interface in the invention of *Debois* because this would provide a familiar and inexpensive route for communication between system components.

With respect to Claims 11-13, see the discussion of Claim 1. *Debois* does not specifically disclose a human readable identifier on the meter. *Gillerion* discloses such an identifier as a serial number at Col. 3, lines 32-44. It would have been obvious to one of ordinary skill in the art at the time of the invention to include such a plate having a serial number to uniquely identify the meter. It would further have been obvious to have correspondence between internal and external identifiers to avoid confusion in meter identification.

With respect to Claim 22, see the discussion of Claims 21 and 6.

With respect to Claims 27-29, see the discussion of Claims 15 and 11-13.

Claims 9 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,381,590 *Debois* in view of US 2002/0046192 *Allport et al.*

Regarding Claim 9, *Debois* discloses the invention substantially as claimed. *Debois* does not specifically disclose a closed location of a printer. *Allport* discloses a closed postage

Art Unit: 3624

meter system at para. 35, the same basic device as disclosed by *Debois*. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the closed printing function of *Allport* in conjunction with *Debois* because this would provide a unified device for postage meter service.

With respect to Claim 25, see the discussion of Claims 24 and 9.

Claims 7, 10, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,381,590 *Debois* in view of US 6,151,591 *Pierce et al.*

Regarding Claim 7, *Debois* discloses the invention substantially as claimed. *Debois* does not specifically disclose a virtual entity. *Pierce* discloses a virtual postage meter, the same basic device as disclosed by *Debois*, at Summary of the Invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the postage meter of *Debois* in the virtual implementation of *Pierce* because this would provide advantages described by *Pierce* at Col. 3, line 63 to Col. 4, line 54.

Regarding Claim 10, *Debois* discloses the invention substantially as claimed. *Debois* does not specifically disclose an open postal system device with external printing. *Pierce* discloses this limitation at Fig. 2B and Background of the Invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the open printing features of *Pierce* in conjunction with *Debois* because this would provide access to inexpensive, available printing services.

With respect to Claim 23, see the discussion of Claims 24 and 7.

With respect to Claim 26, see the discussion of Claims 24 and 10.

Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,381,590 *Debois* in view of US 5,590,198 *Lee et al.*

With respect to Claims 32-33, the discussion of claim 31. *Debois* does not specifically disclose use of secure authorization of a postage meter (entity). *Lee* discloses this limitation at Summary of the Invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to include such authorization in the method of *Debois* because this would help allow users to appropriately assign the entity to new applications within their purview.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/785,654

Page 12

Art Unit: 3624

crk

June 30, 2005

Examiner Charles Kyle

A handwritten signature in black ink, appearing to read "Charles Kyle", written in a cursive style.